



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,895	03/30/2004	Hideki Kuwajima	43890-670	1335

20277 7590 03/07/2007  
MCDERMOTT WILL & EMERY LLP  
600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER
----------

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT	PAPER NUMBER
----------	--------------

2627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/811,895

Applicant(s)

KUWAJIMA ET AL.

Examiner

William J. Klimowicz

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-15 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4,5,8-12,14,15 and 18 is/are allowed.
- 6) ☒ Claim(s) 3 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2007 has been entered.

### ***Claim Status***

Claims 6, 7, 16, 17 and 19-22 have been voluntarily cancelled by the Applicant.

Claims 1-5, 8-15 and 18 are currently pending.

Applicant's election without traverse of Species I (corresponding to Figures 1-4) in the reply filed on June 30, 2006, was previously acknowledged.

Claim 5, 9, 11 and 15 are currently rejoined at this time, based on indicated allowable subject matter of claims 1 and 10.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claims 3 and 13, the phrase “wherein the rotor hub and the rotor-side bearing member *are made of a same material* and formed integrally” lacks support in the disclosure as originally filed (emphasis added). More concretely, in an amendment filed on April 19, 2006, claim 3 was amended to add the phrase “are made of a same material and” to original claim 3. There is, however, no support for such a description of the rotor hub relative to the rotor-side bearing in the original disclosure. Although the rotor hub and rotor side bearing may indeed be “fabricated into a single component,” this component need not be homogeneous in its composition, or in fact, could simply be two separate components, molded into one. Claim 3, as amended, requires a single material, for which there is no support in the original disclosure.

As set forth in MPEP 608.04(a):

Matter not in the original specification, claims, or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See *Ex parte Vander Wal*, 109 USPQ 119, 1956 C.D. 11, 705 O.G. 5 (Bd. App. 1955) (physical properties), *Ex parte Fox*, 128 USPQ 157, 1960 C.D. 28, 761 O.G. 906 (Bd. App. 1957) (new formula) and *Ex parte Ayers*, 108 USPQ 444 (Bd. App. 1955) (new use).

The Applicant alleges at page 7 of the Amendment & Response filed on February 13, 2007:

In the pending Office Action, the Examiner appears to have failed to respond to the applicants argument in support of the above cited limitation of claims 3 and 13. As stated previously, the passage on page 11, line 27-page 12, line 4 of the specification states "here, rotor hub 2 and rotor-side bearing member 3 *need not be made as separate components*". Thus, they may be made of the same material! If two elements are not made as separate components, then they must be made as the same component, and therefore can be made of the same material.

As discussed previously by the Examiner, and apparently overlooked by the Applicant, the Examiner maintains that although the rotor hub and rotor side bearing may indeed be "fabricated into a single component," this component *need not be homogeneous* in its composition, or in fact, could simply be *two separate components of differing materials, molded into one*. Claim 3, as amended, requires a *single* material, for which there is no support in the original disclosure.

The Applicant should revise the language of claims 3 and 13 to expressly recite that what is supported in the Applicant's original disclosure.

### ***Response to Arguments***

Applicant's arguments filed October 17, 2006 have been fully considered but they are not persuasive.

The Applicant alleges:

the passage on page 11, line 27-page 12, line 4 of the specification states "here, rotor hub 2 and rotor-side bearing member 3 need not be made as separate components". This phrase can be interpreted to support the claim limitation that the rotor hub and rotor-side bearing member are made of the same material. If two elements are not made as separate components, then logic dictates that they are made as the same component, and therefore made of the same material. While the Examiner suggests that the

component need not be homogeneous in its composition, there is no indication that the component is not homogeneous. Thus, the specification does support the claim limitation that the rotor hub and the rotor-side bearing member are made of a same material. Accordingly, Applicants respectfully request that the §112 rejection of claims 3 and 13 be withdrawn.

The Examiner respectfully disagrees based on the Applicant's disclosure, as originally filed. More concretely, claims 3 and 13 recite the phrase "wherein the rotor hub and the rotor-side bearing member *are made of a same material* and formed integrally" (emphasis added). Such a recitation, however, lacks support in the disclosure as originally filed. As noted previously, in an amendment filed on April 19, 2006, claim 3 was amended to add the phrase "are made of a same material and" to original claim 3. There is, however, no support for such a description of the rotor hub relative to the rotor-side bearing in the original disclosure. Although the rotor hub and rotor side bearing may indeed be "fabricated into a single component," this component need not be homogeneous in its composition, or in fact, could simply be two separate components, formed of completely different material, molded or affixed to each other in one integral piece. Claim 3, as well as claim 13, requires a single material, for which there is no support in the original disclosure.

***Allowable Subject Matter***

Claims 1, 2, 4, 5, 8-12, 14, 15 and 18 are currently allowed over the art of record.

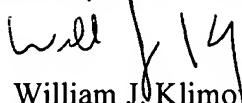
Art Unit: 2627

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
William J. Klimowicz  
Primary Examiner  
Art Unit 2627

WJK